

### REMARKS

Applicants respectfully request reconsideration followed by allowance.

Applicants have slightly revised claim 8 consistent with their specification. The objection to claim 8 is overcome.

The rejection of claim 7 should be withdrawn. The claim is supported by written description, including an Example, and the Examiner admittedly understands how an anti-leaching property for a polyurethane composition can be improved consistent with the specification. Under the Examiner's thesis, it is not seen how any Applicant could satisfy §112 in any application. Nonetheless, Applicants present a revised claim preamble but stress the clarity sought does not surrender claim scope.

Claim 8 is a method to dye a polyurethane. The specification discloses this for any person skilled in the art. The rejection on grounds of enablement is not well taken and Applicants respectfully suggest it be reconsidered and withdrawn.

New claims 11 et seq. relate to the specification at page 10 and page 13.

The Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 2, 3 and 5-10 over JP-46-27874 in view of Ishii '744 or JP 93070 or JP-57-108154.

The Abstract of JP '874 seems to pertain to a composition of a poly[beta-(diethylamino) ethyl methacrylate and a hindered phenol, and nothing to do with a different resin or polymer system, *e.g.* a polyurethane.

The primary reference is silent regarding the use of hindered phenol antioxidants.

The primary reference is silent regarding avoiding discoloration or leaching of ingredients from a polyurethane, nor any reduction in leaching while dyeing a polyurethane.

Even if individual ingredients may have been known, the rejection founders nonetheless because there is no direction to combine the ingredients with a reasonable expectation of successfully attaining the present claimed process. There must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998); see also In re Werner Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). A rejection cannot be predicated on the mere identification of individual components of claimed limitations. There must be a factual prior art based reason to combine the references, otherwise there is no prima facie case of obviousness.

Here there are no specific facts addressed to support the hypothetical combination of references, and there is, accordingly, no *prima facie* case of obviousness.

In addition to the shortcomings in the primary reference, the secondary Ishii '744 reference vitiates any factual predicate to the rejection. In Table 2, col. 5 to 7, particularly in the Comparative Examples, Ishii '744 discloses that many phenol type compounds are not effective. *Arguendo*, some of the phenol compounds might arguably be within the scope of the present hindered phenol compound, but Ishii '744 nonetheless teaches away due to its discouraging reported results. That is evidence of unobviousness.

The alternative grounds of rejection erected upon the JP '874 in view of JP '070 or JP '074 in view of JP '154 is thought to founder too. In addition to the shortcomings of JP '874, JP '070 is silent as to a NO<sub>x</sub> resistant property and is silent regarding NO<sub>x</sub> resistance being related to preventing discoloring or coloring of a polyurethane. The JP '154 is silent regarding

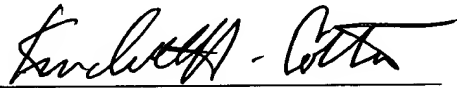
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the hindered phenol compound and the amide compound, and there is therefore no suggestion of either their combination or the selection of the amide in particular.

Having all matters being addressed, a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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